REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 9, 2004 ("Office Action"). At the time of the Office Action, Claims 1-18 were pending in the application. Applicants respectfully request reconsideration and favorable action in this case.

Interview Summary

Applicants thank the Examiner for conducting the telephone interview on October 5, 2004, and for the thoughtful consideration of this case. During the telephone interview, Applicants and Examiner discussed the sufficiency of the 1.131 Declaration submitted on July 19, 2004, to swear behind U.S. Patent No. 6,591,324 issued to Chen et al. ("*Chen*") . It is Applicants' understanding that no agreement was reached regarding the sufficiency of the Declaration.

Information Disclosure Statements

Three Information Disclosure Statements (IDS) and accompanying PTO-1449 forms were submitted on March 22, 2004, April 15, 2004, and July 19, 2004, respectively. The Examiner has not provided an indication that the references submitted in the three IDSs were considered by the Examiner. For the Examiner's convenience, Applicants have enclosed copies of the previously submitted IDSs and PTO-1449 forms. Additionally, Applicants have included copies of the date-stamped postcards indicating the submission of the IDSs. Applicants respectfully request that the Examiner consider the cited references, if not already considered, and provide the appropriate indication that they have been considered by initialing next to the references on the PTO-1449 forms.

The *Chen* Reference

The Examiner rejects Claims 1-5, 10, 11, and 13-17 under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent No. 6,591,324 issued to Chen et al. ("*Chen*"). For the following reasons, Applicants respectfully submit that the *Chen* reference is not prior art to Applicants' claims.

Applicants submit that the *Chen* reference is unavailable as prior art to Applicants' claims. On July 19, 2004 and in response to the Examiner's previous Office Action, Applicants filed a declaration ("Declaration") under 37 C.F.R. § 1.131 concurrently with a Response to Office Action. For the convenience of the Examiner, a photocopy of the Declaration and attached exhibits is attached to this Response to Office Action.

Applicants submit that the Declaration alone provides the evidence necessary to swear behind *Chen*. The M.P.E.P. merely states that "[e]vidence in the form of exhibits **may** accompany the affidavit or declaration." M.P.E.P. § 715.07. In contrasting the evidence required in a 1.131 declaration with the evidence required in an interference proceeding, the M.P.E.P. further states that "in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration." M.P.E.P. § 715.07 (emphasis added). Rather, "an applicant may stand on his or her own affidavit or declaration if he or she so elects." M.P.E.P. § 715.07 (citing *In re Hook*, 102 U.S.P.Q. 130 (Bd. App. 1953). Thus, the M.P.E.P. clearly establishes that a declaration alone is sufficient evidence to overcome a prior art reference. Accordingly, Applicants respectfully submit that Applicants' Declaration is sufficient, without reference to the attached exhibits, to predate *Chen*.

The exhibits attached to the Declaration are provided as additional evidence that (i) the subject matter of at least Claims 1, 9, 10, 13, and 16 were conceived prior to July 12, 2000 and (ii) the inventors worked diligently toward the construction of a prototype beginning prior to July 12, 2000. Applicants submit that the exhibits support this contention since the Applicants are in possession of the sixth version of design documents illustrating a substantial completion of the design of the prototype six days after the critical date. To suggest otherwise is to suggest that Applicants conceived the invention, hired a third party to prepare the drawings, designed the prototype to the level of detail of the exhibits and cycled through six versions of the design documents over a six day period, which is highly unlikely. Thus, Applicants respectfully submit that the level of complexity illustrated in the exhibits further corroborates the inventors' statements in the Declaration. Accordingly, Applicants respectfully submit that the Declaration filed on July 19, 2004, is sufficient to predate the *Chen* reference.

For at least these reasons, Applicants respectfully submit that *Chen* is not prior art with regard to Applicants' claims.

To the extent that the Examiner continues to maintain that *Chen* claims the same patentable invention as Applicants claim, Applicants submit that it is the duty of the Patent Office to declare an interference between *Chen* and Applicants' pending patent application. The M.P.E.P. provides that "if the reference is claiming the same invention as the application and its publication date is less than 1 year prior to the presentation of claims to that invention in the application, . . . [t]he reference can then be overcome only by way of an interference." M.P.E.P. § 715.05 Accordingly, should the Examiner continue to maintain that the *Chen* reference claims the same patentable invention as Applicants claim, the Examiner must declare an interference to determine priority between *Chen* and Applicants' pending patent application.

However, Applicants respectfully submit that an interference between *Chen* and Applicants' pending application is not appropriate since Applicants' claims are patentably distinct from *Chen*. The M.P.E.P. states that "[i]f the application (or patent under reexamination) and the domestic reference contain claims which are identical, or which are not patentably distinct, then the application and patent are claiming the 'same patentable invention.'" M.P.E.P. § 715.05. Accordingly, it follows that if the claims are patentably distinct from one another, then the application and patent are not claiming the same patentable invention and an interference is inappropriate in this situation.

Applicants submit that Applicants' claims are patentably distinct from the claims of *Chen*. The independent claims of *Chen* are directed to hot swappable processor cards that are plugged into processor slots of a hot swap bus. (*See*, i.e., Claim 1). A first processor card includes a communications line for communicating with a second processor card that is plugged into the hot swap bus. (*See*, i.e., Claim 1). The second processor card controls signal switching circuitry to electrically disconnect the first processor card from the bus. (*See*, i.e., Claim 1). With respect to the claimed embodiment, the specification of the *Chen* reference provides that "the second processor card 120 may control the signal switching circuit 128 of the first processor card to disconnect the first processor card 120 from the bus 100 if the second processor card 120 determines that the first processor card 120 has malfunctioned." (Column 5, lines 4-8). Applicants' claims are patentably distinct, however, from the features of *Chen* described above. For example, Applicants' Claim 1 is directed to a midplane that includes a master signal control module "operable to communicate control signals to the second communication coupling if the first computing device is not coupled

with the first communication coupling" and "[prevent] communication of the control signals to the second communication coupling if the first computing device is coupled with the first communication coupling." Accordingly, Applicants' claims are patentably distinct form the claims of *Chen* and an interference would be inappropriate in this situation.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stand ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fees are due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge said fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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